

REMARKS

I. Summary Of the Office Action and Advisory Action

Claims 20-34 were pending in the application.

Claims 20-34 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 20-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent number 6,970,837 (“Walker”) in view of United States Patent number 5,664,110 (“Green”).

The Examiner noted that each rejection was maintained in the Advisory Action.

II. The Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected claims 20-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Applicant respectfully submits that the language of claim 20 is clear and satisfies the requirements of 35 U.S.C. § 112, second paragraph. Claim 20 recites, among other things:

(f) determining whether [a] first product is available by querying [a] product database;

(g) based on whether it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table;

(h) based on whether said first product is determined not to have a substitute product indicated in the substitute table, searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database;

(i) based on whether at least one substitute product is found in the product database, sending the customer a recommendation of the at least one substitute product found in the product database;

(j) receiving approval indicating an approved substitute product selected from among the at least one substitute product found in the product database from the customer in response to the recommendation of the at least one substitute product found in the product database; and

(k) in response to the approval, saving the approved substitute product in a shopping cart of the customer and adding the approved substitute product to the substitute table such that a future check of the substitute table for the first product would indicate the approved substitute product.

Claim 20 recites at least two ways that a substitute product can be found. The first way is by “determining whether a substitute product is indicated in a substitute table.” Only if this first way fails, is the second way attempted. The second is “searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database.”

Thus, a substitute product can be a substitute product without being in the substitute table.¹ That is, such a substitute product can be found by “searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database,” as recited in claim 20.

Independent claims 25 and 30 were rejected on the same or similar grounds and have been amended in the same or a similar way. Each of claims 21-24, 26-29, and 31-34 depends from one of claims 20, 25, and 30 and was rejected based on their dependence from a rejected base claim. Accordingly, Applicant respectfully submits that claims 20-34 are definite and that they particularly point out and distinctly claim the subject matter sought to be defined by these claims. Applicants respectfully request withdraw of the rejection under 35 U.S.C. § 112.

III. The Rejection of Claim 20 Under 35 U.S.C. § 103(a)

Claims 20-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in view of Green. In summary, claim 20 recites, among other things, a method that after failing to locate a product requested by a consumer from a catalog that was created based on barcode received from the consumer, and after failing to find a substitute product in a substitute, searches a product database as an alternate way of locating a substitute and, if a substitute is found and approved, adds the approved substitute to the substitute table. Adding the approved substitute to the substitute table avoids, e.g., the issue of having to search through the product database in the future if the same unavailable product is requested again.

Nothing in Walker, alone or in combination with Green, teaches or suggests, for example, searching a product database for a substitute product **contingent** on not finding a substitute

¹ The Office Action stated “It is unclear from this limitation how a substitute product could be a substitute product without being in the substitute table.” (Office Action, page 2).

product in a substitute table. Instead, Walker merely describes a system that includes a retailer determining substitute products based on various considerations and offering such products to a consumer.

Nor does Walker, alone or in combination with Green, teach or suggest, among other things, adding an approved substitute product to the substitute table for use in a future search. This is not surprising because Walker does not teach or suggest any checking of a second source of substitute products after failing to find substitute product in a first source. Thus, there would be no substitute product from a second source to add the first source of substitute products described in Walker.

Green, which describes a remote ordering system that describes building and editing ordered lists, does not remedy the above discussed deficiencies of Walker, nor does the Office Action assert that it does.

Accordingly, Applicant respectfully submits that claim 20 is allowable and respectfully requests the withdrawal of the rejection to the same.

Each of independent claim 25 and claim 30 recite similar limitations to independent claim 20 and is allowable for at least the reasons provided with respect to claim 20. Claims 21-24, 26-29, and 31-34 each depend from one of claims 20, 25, and 30 and are thus allowable for at least the same reasons as the claim from which they depend are allowable. Accordingly, Applicant submits that claims 21-34 are also allowable and respectfully requests the withdrawal of the rejection to the same.

CONCLUSION AND AUTHORIZATION

Applicant respectfully submits that, as described above, the cited references do not show or suggest the combination of features recited in the claims. Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant has provided examples of why the claims are distinguishable over the cited prior art.

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 08-0219

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,

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